



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/989,896	12/12/1997	MATHIAS GEHRMANN	05552.1337-0	9415

5487 7590 07/01/2004
ROSS J. OEHLER
AVENTIS PHARMACEUTICALS INC.
ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER, NJ 08807

EXAMINER

SAUNDERS, DAVID A

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/989896

Applicant(s)

GEHRMANN et al

Examiner

SAUNDERS

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/3/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22, 25-34 is/are pending in the application.
- Of the above claim(s) 14-22 is/are withdrawn from consideration.
- ☒ Claim(s) 1, 3, 5-7, 10-11, 25-29, 31, 33-34 is/are allowed.
- ☒ Claim(s) 4, 8, 12-13, 30, 32 is/are rejected.
- ☒ Claim(s) 2, 9 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/3/04 has been entered.

Claims 1-22 and 25-34 are pending.

Claims 1-13 and 25-34 are under consideration.

Claims 2 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The term "glycosylated" in base claim, inherently conveys covalent bonding of carbohydrate moieties to the polypeptide chain(s); thus recitation of "covalently bonded carbohydrates" in claim 2 adds nothing to claim 1.

Further dependent claim 9 is objected to because glycosylation by means of "chemical methods" or by a selection of "suitable expression system" constitute the full range of possible methods of achieving glycosylation; applicant must recite "chemical methods" and "selection of suitable expression systems" in two separate claims depending from base claim 1.

Claims 4, 8, 12-13, 30 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 8 are unclear by reciting "the antigen binding region" in the singular while base claim 1 requires "two or more antigen binding regions" in the plural.

Claim 30 is unclear for the like reason of reciting "antigen binding region" in the singular. By next reciting an "sFv-B-lactamase fusion protein" in claim 30 and its dependent claims 12-13, it is not clear whether this refers to the entire fusion protein (which would then be inconsistent with base claim 1 requiring "two or more antigen binding regions") or to only a portion of the fusion protein. Further dependent claim 32 is included in the rejection. This rejection is not deemed trivial, since the phrase "sFv-B-lactamase fusion protein" appeared in claims 12-13 as originally filed, at which time base claim 1 would have encompassed such a fusion protein, with no additional sFv segments.

The amendment filed on 5/3/04 has overcome the previously stated prior art rejections in the action of 12/3/03.

The examiner notes that Hellstrom et al teach nothing about the glycosylation of sFv or of fusion proteins containing sFv.

Likewise Borstel et al teach nothing about glycosylation.

The examiner reiterates that Huston et al 5,258,498 teach nothing about the glycosylation of sFv or of fusion proteins containing sFv. The examiner notes,

therefore, that the previously stated rejection (action of 12/03/03, at page 3) over Bosslet et al and other primary references in view of Huston et al and Bosslet et al should not have included claims 2 and 9 in the rejection.

The examiner notes that Winter et al (6,248,516) teach nothing about glycosylation of sFv. Therefore, the rejection over the combination of Winter et al in view of Huston et al (action of 12/03/03 at page 6) should not have rejected claims 2 and 9.

Non-elected claims 14-22 must be cancelled prior to allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, PhD whose telephone number is 571-272-0849. The examiner can normally be reached on Monday-Thursday from 8:00a.m to 5:30p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 08/989,896

Page 5

Art Unit: 1644

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Saunders/tgd

June 16, 2004

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182/1644